Serial No.: 09/690,199 Response to Office Action

Davis Law Group, P.C.

Docket No. 1005.7 Customer No. 53953

<u>REMARKS</u>

Applicant respectfully requests reconsideration of this application in view of the following remarks. Claims 31, 32, 39, 40, 47 and 48 have been cancelled. Claims 1, 8, 15, 25-30, 33-38 and 41-46 are pending.

Rejection of the claims

The most recent Office Action rejected claims 1, 8 and 15 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,992,687 ("Baird").

Claim 1 recites:

1. A method performed by a computer system, comprising: storing an electronic version of a paper, wherein the electronic version is displayable on a display device as a likeness of the paper; and

in response to content of a first portion of the likeness, forming a hyperlink reference and embedding the hyperlink reference within the first portion of the likeness, wherein the hyperlink reference is associated with a second portion of the likeness, such that when the first portion of the likeness is displayed on the display device, at least a portion of the content is selectable by a user to cause the computer system to display the second portion of the likeness on the display device, and wherein the content is at least one of the following: a term that indicates a location at which the second portion of the likeness is located within the paper; and a phrase that indicates the location.

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Claim 8 recites:

8. A system, comprising:

a computing device for:

storing an electronic version of a paper, wherein the electronic version is displayable on a display device as a likeness of the paper; and in response to content of a first portion of the likeness, forming a hyperlink reference and embedding the hyperlink reference within the first portion of the likeness, wherein the hyperlink reference is associated with a second portion of the likeness, such that when the first portion of the likeness is displayed on the display device, at least a portion of the content is selectable by a user to cause the computing device to display the second portion of the likeness on the display device, and wherein the content is at least one of the following: a term that indicates a location at which the second portion of the likeness is located within the paper; and a phrase that indicates the location.

Claim 15 recites:

- 15. A computer program product stored on a tangible computer-readable medium, comprising:
- a computer program processable by a computer system for causing the computer system to:

store an electronic version of a paper, wherein the electronic version is displayable on a display device as a likeness of the paper; and in response to content of a first portion of the likeness, form a hyperlink reference and embed the hyperlink reference within the first portion of the likeness, wherein the hyperlink reference is associated with a second portion of the likeness, such that when the first portion of the likeness is displayed on the display device, at least a portion of the content is selectable by a user to cause the computer system to display the second portion of the likeness on the display device, and wherein the content is at least one of the following: a term that indicates a location at which the second portion of the likeness is located within the paper; and a phrase that indicates the location.

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In MPEP § 2131, the PTO provides that:

"[t]o anticipate a claim, the reference must teach every element of the claim...."

Therefore, to sustain a rejection of claim 1, Baird must contain all of the above-recited elements in claim 1. However, Baird fails to teach the combination of elements in claim 1. In fact, Baird teaches away from such a combination.

For example, claim 1 recites (in part), "in response to content of a first portion of the likeness, forming a hyperlink reference and embedding the hyperlink reference within the first portion of the likeness, wherein the hyperlink reference is associated with a second portion of the likeness, such that when the first portion of the likeness is displayed on the PAGE 15/15 * RCVD AT 7/25/2006 12:23:13 AM [Eastern Daylight Time] * SVR:USPTO-EFXRF-3/9 * DNIS:2738300 * CSID:512 306 8374 * DURATION (mm-ss):04-32

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